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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES B. McCORMICK

Appeal 2009-006476
Application 10/720,330
Technology Center 1700

Decided: March 29, 2010

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of pending claims 6-14. (Appeal Brief filed February 18, 2008, (hereinafter "App.Br.") at 2.) We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We REVERSE.

Appellants describe a system of stackable tissue processing cassettes.
(Spec. para [0007]-[0009].) Claim 6 is illustrative and recites:

6. A system of stackable tissue processing cassettes comprising:
 - a first cassette, the first cassette comprising a bottom wall, a front wall, a back wall, and two side walls with the bottom wall, the front wall, the back wall, and the side wall forming a first container having a top opening, wherein a histological specimen can be placed within the first container through the top opening of the first container; and
 - a second cassette, the second cassette comprising a bottom wall, a front wall, a back wall, and two side walls with the bottom wall, the front wall, the back wall, and the side wall of the second cassette forming a second container, the bottom wall of the second cassette includes a plurality of apertures extending therethrough, wherein the first cassette can be interlocked with the second cassette such that the bottom wall of the second cassette closes the top opening of the first container to prevent the histological specimen from exiting the first container, wherein the plurality of apertures of the bottom wall of the second cassette allow liquid paraffin to flow from one of the first and second containers and into the other of the first and second containers while the first and second cassettes remain interlocked.

(App. Br. 29, Claims Appendix.)

The Examiner rejected claims 6 and 10-14 under 35 U.S.C. § 103(a) as being unpatentable over Mathus (U.S. 5,856,176, issued Jan. 5, 1999) in view of Berry (U.S. 5,240,854, issued Aug. 31, 1993).

The Examiner rejected claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Mathus in view of Berry, and further in view of Intengan (U.S. 4,440,301, issued Apr. 3, 1984).

In rejecting the claims on appeal, the Examiner found that Mathus discloses a system of stackable tissue processing cassettes including a

plurality of apertures along the base walls and side walls to facilitate air circulation between the cassettes. (Examiner's Answer entered May 13, 2008, (hereinafter "Ans.") at 4.) The Examiner stated "Berry is not relied upon for teachings regarding the use of a plurality of apertures along the bottom wall of the second cassette because this is clearly disclosed by Mathus." (Ans. 8.)

Appellant contends, *inter alia*, that Mathus discloses that apertures may be formed in the base sidewall or the lid of a culture dish, but that Mathus does not disclose apertures in the bottom wall of the culture dish. (Reply Brief filed June 16, 2008, (hereinafter "Rep. Br.") at 8-9.)

ISSUE

Did the Examiner err in determining that Mathus discloses a system of stackable tissue processing cassettes with a plurality of apertures in a bottom wall of a second cassette?

We answer this question in the affirmative.

FINDINGS OF FACT

The record supports the following Findings of Fact (FF) by a preponderance of the evidence.

1. Mathus discloses that a plurality of culture dish bases without lids may be stacked on top of each other. (Col. 4, ll. 25-27.)
2. Mathus discloses that in order "to provide the gas exchange needed for growing tissues cells . . . apertures can be formed in the base sidewall or the lid." (Col. 5, ll. 51-56.)

PRINCIPLES OF LAW

The Examiner bears the initial burden, on review of prior art or on any other ground, of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In order to establish a prima facie case of obviousness, the Examiner must show that each limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *See, e.g., In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

ANALYSIS/CONCLUSION

We agree with Appellant that the combination of Mathus and Berry fails to render obvious a system of stackable tissue processing cassettes where “the bottom wall of the second cassette includes a plurality of apertures extending therethrough” as required in independent claims 6 and 13.

Specifically, Mathus does not disclose a second cassette having a plurality of apertures in a bottom wall. Mathus discloses that apertures are present in the “base sidewall or the lid.” (FF 2.) The Examiner does not provide a reason to modify the apertures of Mathus used to enable gas exchange in such a way as to include them in the base cavity. Thus, even if one of ordinary skill in the art were to ensure that liquid could flow through the apertures as the Examiner suggests, the structure of the resulting cassettes would still fail to meet all of the limitations recited in the claims. Accordingly, we are constrained to reverse the Examiner’s rejection of claims 6 and 10-14.

Regarding the rejection of claims 7-9, Intengan fails to cure the deficiencies of Mathus in view of Berry as previously discussed. Therefore, we reverse the Examiner's rejection for the same reasons.

ORDER

We reverse the Examiner's decision rejecting claims 6-14 under 35 U.S.C. § 103(a).

REVERSED

rvb

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